

REMARKS

Claims 1-19 are currently pending in this application. No amendments have been made, and therefore, no new matter has been added.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-4, 7-8, 10 and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,231,184 (“Corris *et al.*,” hereinafter, “Corris”) in view of U.S. Patent No. 5,158,212 (“Sirhan”) and U.S. Patent No. 5,647,787 (“Raviv *et al.*,” hereinafter “Raviv”).

Claims 5-6 and 11-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Corris, Sirhan and Raviv and further in view of U.S. Patent No. 4,973,286 (“Davison”).

Claim 9 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Corris in view Sirhan and Raviv and further in view of U.S. Patent No. 4,670,864 (“Hoffman”).

Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Corris in view Sirhan and Raviv and further in view of Davison and Hoffman.

Withdrawal of the rejections of all of the claims is respectfully requested for at least the following reasons.

Corris, Sirhan and Raviv are not properly combinable because there is a lack of motivation to combine Corris with either Sirhan or Raviv in the manner suggested by the Examiner. Without the combination of Corris, Shirhan and Raviv, all of the Examiner’s rejections fail.

Corris discloses a toy doll having a sound detection circuit using a microphone, an amplifier, a band pass filter, a timing circuit and transistors that control motors. The timing circuit of Corris is not a peak integrator that controls the output only after receiving a predetermined range of averaged peaks output from the filter. The combination of amplifiers A3, A4, resistor R15 and capacitor C4 responds immediately to a detected audible signal of 14 KHz output from a bandpass filter amplifier A2. The timing circuit (resistor R15 and capacitor C4) determines how long the control output will drive the motor(s) 38 and 58 (i.e., one output from amplifier A4 drives both

transistors Q1, Q2 to activate motors 32, 58). Motor 58 in turn drives a turntable 48 with a needle 66 that transmits directly to a speaker 94. Therefore, the digital control output from transistor Q1 drives voice unit motor 58. In addition to a circuit actuated by a particular sound frequency, Corris describes an alternate embodiment initiated by a single radio frequency (300 KHz).

Raviv discloses a sound controlled toy having a microcontroller 200 that provides outputs to drive motors 220, 222, outputs to lights 36 and a sound output indication via a speaker driver 224 to a loudspeaker 226. See Fig. 8. Raviv merely suggest that the sound output provides voice outputs (col. 5, lines 10-15) and that the voice output provides acknowledgements in “learn mode” (col. 5, lines 58-65). Raviv discloses that the movements are accompanied by periodic eye illumination and sounds, preferably including roars or other voice outputs. See col. 5, lines 49-51.

It is well-settled that while making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. MPEP § 2142. The Examiner can satisfy this burden *only* by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. *In re Fine*, 5 USPQ.2d 1596, 1598 (Fed. Cir. 1988); See also MPEP § 2142.

The Examiner asserts it would be obvious to include the peak integrator, as taught by Sirhan, in the apparatus of Corris for the purpose of improving sound detection quality and eliminating false triggering. The Examiner has not identified how sound detection quality would be improved. Corris operates by detecting a single, predetermined frequency. Sirhan is designed for voice activation by any potential user and does not appear to be bandwidth limited. Rather, it operates by integrating minimum amplitude over a minimum time duration. Corris discloses that single frequency activation is suitable for use with either a sonic or radio wireless remote control. The Corris doll activates when the child desires by activating the remote, rather than simply loud noise next to the doll. Voice activation is not an asset. Children (e.g., little girls) tend to talk to their dolls like a mother to a child. In such a conventional play pattern, the doll would have to be configured and the child would have to be taught to raise its voice in order to activate the doll. A child might also raise its voice in order to express anger or to discipline the doll, which would also be likely to trigger an undeserved activation.

Furthermore, Corris expressly states that its disclosed filter "... is desirable to discriminate against spurious sound signals that might otherwise inadvertently activate motors 32 and 58." (Corris, col. 4, lines 46-48). Nothing in Corris or Sirhan discloses or even suggests that the existing single frequency sound detection system of Corris is faulty or inadequate in some way. Moreover, nothing in either reference discloses or even suggests that the amplitude/time sound detection system of Sirhan is better than or even generally equivalent to the frequency detection circuit of Sirhan for use in the infant doll disclosed in Corris. In fact, based on conventional play patterns, the contrary is suggested. For these particular references, the Examiner's bare conclusion of improved performance are simply unsupported.

The Examiner has failed to consider the Corris and Raviv inventions as a whole, but instead has picked out features of Raviv's sound controlled toy to abstractly modify the electromechanical remote-controlled doll of Corris. Since the toy doll of Corris already had a pre-recorded voice unit generated by turning a turntable 54 to play a disc 60 as well as control outputs for controlling a movement motor, there would be no need for the controller that generates a voice output and outputs that drive motors as set forth in Raviv.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ.2d 1788 (PTO Bd. Pat. App. & Int. 1986); MPEP § 2142. Further, the mere fact that the prior art *could be modified* in the manner proposed by the Examiner does not make the modification obvious unless the prior art suggested desirability of the modification. *Ex parte Dussaud*, 7 USPQ.2d 1818, 1820 (PTO Bd. Pat. App. & Int. 1988). As the Federal Circuit has pointed out, "It is impermissible to use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ.2d at 1600. Moreover, something in the prior art *as a whole* must suggest the desirability, and thus the obviousness of the invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ.2d 1434, 1438 (Fed. Cir. 1988); see also MPEP § 2143.

The Examiner fails to point to any motivation to combine the references other than cursorily suggesting that the controller of Raviv could be provided for the purpose of providing increased amusement stimulation for the user. But, Corris already provided pre-

recorded voice outputs via an electromechanical turntable and that drives movement motors, and therefore, the Examiner's assertion is unsupported.

Applicant therefore respectfully submits that claims are not obvious under 35 U.S.C. § 103(a) in view of the combination of Corris, Sirhan and Raviv because there is a lack of motivation to combine Corris and Sirhan or Corris and Raviv in the manner suggested by the Examiner and all of the rejections rely on the combination of at least these references. Accordingly, Applicant respectfully requests that the rejection of claims 1-19 under 35 U.S.C. § 103(a) be withdrawn.

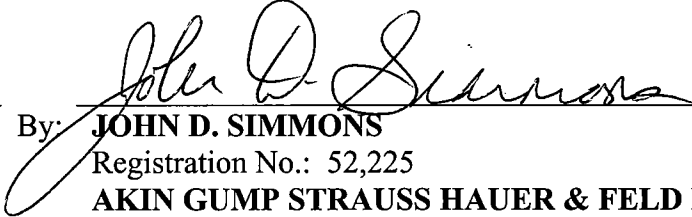
CONCLUSION

In view of the foregoing Amendments and Remarks, it is respectfully submitted that the present application, including claims 1-19, is in condition of allowance.

Respectfully submitted,

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